

### REMARKS

Claims 1-16 are pending in the present application. Claims 1, 4, 7 and 12 have been amended herewith. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over MacInnis (U.S. Patent No. 6,487,723, filed May 4, 1999) (hereinafter "MacInnis"), in view of Saether et al. (U.S. Patent No. 6,405,219; filed Sep. 24, 1999) (hereinafter "Saether"). This rejection is respectfully traversed.

With respect to Claim 1, Applicants urge that none of the cited references teach or suggest the claimed step of "downloading data required for said software maintenance action from a sequence of repositories, wherein said sequence of repositories includes at least a top-level repository storing a set of files for the product and a local-level repository storing a first subset of files for the product, wherein the first subset of files is specific for a given client system". In rejecting Claim 1, the Examiner states that MacInnis teaches:

"performing a software maintenance action for the product (e.g. Fig. 3, col. 5, lines 11-25) from the client side by **downloading** the data required for said maintenance **from a combination of a top-level repository** storing a set of files for the product (c.g. system 200, Fig. 2) **and a local-level repository** storing a first subset of files for the product (e.g. terminal 203, 204, Fig. 2; internal table – col. 4, line 45 to col. 5, line 25 – Note: internal table and local storage of files or hardware modules at terminal reads on local-level repository storing subset of files specific to a given client), wherein the first subset of files is specific for a given client system" (emphasis added by Applicants)

Applicants show error, in that Claim 1 specifically recites a client site, and that data is downloaded from a top-level repository *and* a local-level repository. To the extent MacInnis terminal is interpreted to be the claimed local level repository, then MacInnis

does not teach the claimed 'client site'. Perhaps even more importantly, information in the MacInnis terminal, including information in the internal tables and local storage, is not downloaded. Claim 1 recites a top-level repository, a local-level repository and a client site. As a part of performing a maintenance operation for a product from a client site, data is downloaded from both the top-level repository and the local-level repository. Contrary to the Examiner's assertion, MacInnis does not teach a client site, and that data is downloaded *from* (1) a top-level repository *and* (2) a local-level repository (the two repositories being different from the client site). Thus, the Examiner's reasoning in rejection Claim 1 is shown to be in error.

Applicants further show error in the Examiner's rejection of Claim 1. The Examiner acknowledges that the MacInnis reference does not teach downloading from a sequence of repositories (Applicant note: this appears to be directly contrary to the Examiner's position, quoted above), but cites Saether as teaching distribution of software in sequence from a more global server to more secondary global servers before updating the target machines. Applicants urge that Saether teaches the updating of source files on content servers (column 1, lines 10-14), and has nothing whatsoever to do with maintaining software products in client computer systems. Thus, even to the extent Saether may show multiple servers, where source content is copied from one server to another, such technique is not useful for managing or maintaining programs in client computer systems. By analogy, a teaching of how to distribute power from a power plant to a local neighborhood substation is very different from how to manage wiring or distribute power internal to a household. The system characteristics, equipment, power levels, etc. are very different between such diverse environments, and a high voltage distribution technique is not applicable to a low voltage home use. Similarly, a technique for distributing source content to web content servers is not germane to a technique for managing or maintaining software products in a client computer system. Thus, a person of ordinary skill in the art would not have been motivated to combine teachings from such a dissimilar operating environment/framework with the teachings of MacInnis.

Even if one were to improperly combine such dissimilar references, there is still no teaching or suggestion of "performing a software maintenance action for the product from a client site by *downloading data* required for said software maintenance action

*from a sequence of repositories, wherein said sequence of repositories includes at least a top-level repository storing a set of files for the product and a local-level repository storing a first subset of files for the product, wherein the first subset of files is specific for a given client system". While Saether may teach multiple servers, and the download of data from one server to another, this download of data is merely data replication between servers. Such action does not in any way teach or suggest performing a software maintenance action for a product from a client site by downloading data required for said software maintenance from a sequence of repositories where the sequence of repositories includes at least a top-level repository storing a set of files for the product and a local-level repository storing a first subset of files for the product, wherein the first subset of files is specific for a given client system. In any event, Applicants have amended Claim 1 to even further distinguish the claimed invention from the teachings of the cited references.*

Applicants initially traverse the rejection of Claims 2-6 for similar reasons given above with respect to Claim 1.

Further with respect to Claim 4, Applicants urge that none of the cited references teach or suggest the claimed feature of "generating an input list of files downloadable *from said sequence of repositories*" (emphasis added). In rejecting this claimed feature, the Examiner states that MacInnis teaches:

"generating of an input list downloadable from a server repository (e.g. Table T, broadcast all versions – col. 4, lines 23-44; Fig. 2)."

Applicants urge that Claim 4 does not merely recite 'a server repository', as alleged by the Examiner in rejecting Claim 4. Rather, Claim 4 explicitly recites 'a sequence of repositories' for which a list is generated. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Applicants). *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). As the Examiner has failed to establish a prima facie case of

obviousness, as the Examiner has failed to establish, or even allege, a teaching of “generating an input list of files downloadable from said sequence of repositories”, the rejection is improper. In addition, as the Examiner has failed to establish a prima facie showing of obviousness with respect to Claim 4, the burden has not shifted to Applicants to rebut an obviousness assertion<sup>1</sup>.

Still further with respect to Claim 4, Applicants urge that there would have been no reason or other motivation to modify the teachings of the cited references to include the claimed feature of “generating an input list of files downloadable from said sequence of repositories”, because in both systems (MacInnis and Saether) data is downloaded to a given device from a single upstream device so there would be no reason for generating a list of files downloadable from multiple sources. This further evidences non-obviousness of Claim 4.

Applicants further traverse the rejection of Claim 5 for reasons given above regarding Claim 4 (of which Claim 5 depends upon).

Still further with respect to Claim 5, Applicants urge that none of the cited references teach or suggest the claimed feature of “a total input list is generated by subsequently accessing the repositories and by merging input lists for each repository with a priority of more local files” (emphasis added by Applicants). In rejecting Claim 5, the Examiner states that MacInnis teaches a version differential matching of input lists (e.g. Fig. 3-5) with a priority of local files (e.g. internal table – col. 4, line 45 to col. 5, line 25), and that Saether discloses “the merge into a delivery list of identified files retrieved from with isolated source servers to yield a final delivery version list for being activated at the target machines (e.g. Fig. 3A)”. Applicants urge that none of the above teaching characterizations establishes the claimed ‘priority of more local files’ as a part of merging input lists. The Examiner states that “the requirement that priority be given to match local files at the target machine is inferred or implicitly disclosed from the teachings of Saether”. Applicants urge that this ‘inferred or implicit’ disclosure is certainly not the case. Saether merely describes a distribution scheme for downloading

<sup>1</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

files to servers (secondary global servers and content servers). It does not describe any ability to update a client computer system with such files, and thus cannot describe (implicitly or otherwise) a specific operational step that is a part of maintaining software products in client computer systems. Even if the Examiner were to unreasonably interpret Saether's content servers as reading on the claimed client systems, the files distributed to these web content servers are customized based upon the file structure and hardware constraints of the individual content servers (column 1, lines 41-44). Such distribution customization is not in any way based on any priority of local files, but rather is based on the particular hardware configuration of the content server itself. Thus, even with such unreasonable interpretation of Saether's content servers reading on the claimed client systems, there is still no implicit or implied teaching of "*merging input lists for each repository with a priority of more local files*" as expressly recited in Claim 5. Thus, Claim 5 is further shown to not be obvious in view of the cited references.

Further with respect to Claim 6, Applicants urge that none of the cited references teach or suggest the claimed feature of "integrating files into the target system which have been identified by a look-aside procedure as residing in a neighbor system easier to be accessed by the target system than one of said repositories". In rejecting Claim 6, the Examiner states that "Official notice is taken that a search being performed in a network designed so to provide alternative to reach for the nearest node or target point most easily accessible, or to seek out for the least resistive path was a well-known concept in the search algorithm at the time the invention was made". Applicants urge that such "well-known" reasoning in rejecting Claim 6 as being obvious is contrary to law. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together

elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). Applicants thus show that the Examiner is using an illogical and inappropriate process in rejecting Claim 6, and thus Claim 6 is shown to have been erroneously rejected based on this "well-known" assertion.

Still further with respect to Claim 6, Applicants urge that the fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no suggestion of any desire to modify the teachings of the cited references to include the claimed look-aside procedure. The cited MacInnis reference downloads data from a transmitting source 202 to terminals 203 and 204 in a unidirectional fashion (Figure 2; column 4, lines 22-44), such that the terminals do not have to request content from the source (column 4, lines 36-44). Because of the uni-directional transmission of content, there is no ability for the terminal to somehow determine that a neighbor system can be more easily accessed than one of the repositories. Quite simply, cable TV networks do not have any ability to download data or content from one neighboring terminal to another. Thus, a person of ordinary skill in the art, when presented with the teachings of MacInnis, would not have been motivated to modify the teachings therein in accordance with the claimed look-aside procedure.

As to the teachings of Saether, such reference merely teaches content distribution to content *servers*, and does not describe any technique for maintaining software products in *client* computer systems, and expressly states a desire to update such content servers from an upstream repository, as the upstream repository customizes/tailors the distribution of the set of source files according to the specific content server configuration (column 1, lines 41-44)). Thus, there is no suggestion of any desire to modify the teachings of this cited Saether reference to include the claimed look-aside procedure. In fact, modifying the teachings of Saether in accordance with the claimed invention would eviscerate the expressed purpose of such teachings, as the file distribution would not be customized per the unique configuration of the content server,

strongly evidencing no motivation to modify such teachings in accordance with the claimed invention recited in Claim 6. Accordingly, per the holding in *In re Gordon, Id.*, Claim 6 is further shown to have been erroneously rejected.

With respect to Claim 7, and for similar reasons to those given above with respect to Claim 1, none of the cited references teach or suggest the claimed feature of “wherein a given client computer system from within the plurality of client computer systems performs a software maintenance action for the product by *downloading data required for said software maintenance action from the sequence of repositories*” (emphasis added).

Applicants initially traverse the rejection of Claims 8-11 for reasons given above with respect to Claim 7 (of which Claims 8-11 depend upon).

Applicants further traverse the rejection of Claim 10 for similar reasons to the further reasons given above with respect to Claim 6.

Applicants traverse the rejection of Claims 12-16 for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 14 for similar reasons to the further reasons given above with respect to Claim 4.

Applicants further traverse the rejection of Claim 15 for similar reasons to the further reasons given above with respect to Claim 5.

Applicants further traverse the rejection of Claim 16 for similar reasons to the further reasons given above with respect to Claim 6.

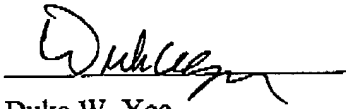
Therefore, the rejection of Claims 1-16 under 35 U.S.C. § 103 has been overcome.

**II. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 2/28/05

Respectfully submitted,



Duke W. Yee  
Reg. No. 34,285  
Wayne P. Bailey  
Reg. No. 34,289  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorneys for Applicants